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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/331,808 01/27/00 LINDQVIST

B 100084.410

HM22/0726  
SEED INTELLECTUAL PROPERTY LAW GROUP  
701 FIFTH AVENUE  
SUITE 6300  
SEATTLE WA 98104-7092

EXAMINER

WESSENDORF, T

ART UNIT

PAPER NUMBER

1627

DATE MAILED:

07/26/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trad marks**

# Office Action Summary

Application No.

09/331,808

Applicant(s)

Lindqvist et al

Examiner

T. Wessendorf

Group Art Unit

1627



☒ Responsive to communication(s) filed on 1/27/00

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1-18 is/are pending in the application

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-18 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☒ The proposed drawing correction, filed on 1/27/00 is ☒ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☒ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 250 words. It is important that the abstract not exceed 250 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same

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and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-18 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification does not provide an adequate written description of the recited functionally-equivalent fragment, variant or derivative of the genetic material or an amino acid sequence derived from a cis-acting protein or functionally-equivalent fragment, variant or derivative thereof. The specification, particularly the examples which demonstrates or aids in the direction of the invention merely presents DNA using specific primers but does not disclose a single fragment or variant or derivative of said DNA or the encoded protein. The terms fragments, variants and derivatives would encompass numerous modifications in the DNA structure, subsequently in the encoded proteins for which the specification mere recitations would not suffice as a written description. There are too numerous undefined factors or conditions to determine each of the fragments, variants or derivative, singly or in combinations.

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A). Claim 1 is indefinite in its recitation of a "diverse population. Is the diverse population refers to the same family of proteins or proteins of different structures, functions etc.. The use of colon(:) in the "protein:DNA" is indefinite as it is not clear as to what said colon refers to.

B). Claim 2 is indefinite as to how a single library member, within the context of the claimed method as to how it can be "optionally present in more than one copy".

C). The metes and bounds of the recited "modified" , within the claimed context is indefinite as the scope of said term is unascertainable.

D). The phrase "and/or" fails to ascertain the claimed invention with precision. E.g, claim 14. Also, the phrase "the

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relevant library member" lacks antecedent support from the claim from which it depends.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 6, 7-9, 11-18 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over . Mattheakis et al (5,922,545).

Mattheakis et al discloses a method of producing a library of peptides or proteins by preparing an amplifiable genetic

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library of DNA molecules which contain a nucleotide sequence that encodes the protein monoclonal antibodies. See e.g., col. 6, line 59 up to col. 18, line 64 and the Examples. The claimed invention is therefore anticipated or obvious over the teachings of Mattheakis.

Claims 1, 6, 7-9, 11-18 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over by Gold (WO 92/02536(I) or WO 93/03172)(II)].

Gold (I) discloses a method of identifying a protein or peptide comprising of preparing an amplifiable gene library of DNA molecules which contain a nucleotide sequence that encodes proteins such as that it binds to the DNA encoding sequence through covalent protein-DNA binding and to which the encoded peptide sequence is displayed and expressing the genetic library formed. See Gold (I) at e.g., page 9, lines 14 up to col. 19 and the Examples. Gold (II) discloses the same method as Gold (I). See the Examples. Each of the Gold references therefore anticipates or renders obvious the claimed invention.

Claims 3-5 are free of prior art.

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The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1627.

Certain papers related to this application may be submitted to Art Unit 1627 by facsimile transmission. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 O.G. 61 (November 16, 1993) and 1157 O.G. 94 (December 28, 1993) (see 37 C.F.R. 1.6(d)). The official fax telephone numbers of the Group are (703) 308-7924. NOTE: If applicant does submit a paper by fax, the original signed copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers in the Office.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to T. Wessendorf whose telephone number is (703) 308-3967. The examiner can normally be reached on Mon. to Fri. from 8 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jyothsna Venkat Ph.D., can be reached on (703) 308-0570. Any inquiry of a general nature or relating to the status of this application or



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proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

*T. Wessendorf*

T. Wessendorf  
Patent Examiner  
Art Unit 1627  
7/21/00